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APR 30 2004

OFFICE OF PETITIONS

In re Application of
Murray E. Stanley
Application No. 08/292,286
Filed: August 18, 1994
Title of Invention: 02196-040205

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: DECISION ON PETITION
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This is a decision on the petition under 37 CFR 1.137(b), filed April 16, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)". This is not a final agency decision.

This application became abandoned on February 17, 1996 for failure to file a proper response to the non-Final Office action mailed November 16, 1995. No extensions of time having been obtained and no responses filed, a Notice of Abandonment was mailed July 8, 1996.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by:

(1) the required reply (unless previously filed), which may be met by the filing of an amendment or a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof;

(2) the petition fee required by 37 CFR 1.17(l);

(3) a statement that the entire delay in filing the required reply from the due date

for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) in a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995.

This petition is submitted with an amendment in response to the non-Final Office Action mailed November 16, 1995, a terminal disclosure and fee and petition but lacks item (3) above.

The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.¹ The fact that this application has been abandoned since 1996 and no petition to revive was filed until 2004 raises a question as to whether or not the delay was in fact unintentional.² Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b).³ Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.⁴

Three periods to be considered during the evaluation of a petition under 37 C.F.R. §1.137(b) are the delay in:

- (1) reply that originally resulted in abandonment and from the abandonment until discovery thereof;
- (2) filing an initial petition pursuant to §1.137(b) to revive the application; and

¹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

³ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁴ See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

(3) filing a *grantable* petition⁵ pursuant to §1.137(b) to revive the application.⁶

This petition fails to make the required showing as to all three periods that the delay was unintentional within the meaning of 35 U.S.C. §41(a)(7) and 37 C.F.R. §1.137(b).

The application became abandoned as a result of non-responsiveness to the November 16, 1995 Office action, and provides no documented explanation for the lack of responsiveness across for more than eight (8) years, and thus fails to satisfy the showing requirement of 37 C.F.R. §1.137(b).⁷

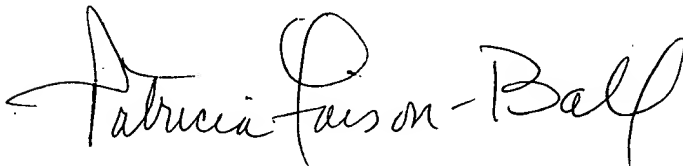
Petitioner must satisfactorily address these issues in any request for reconsideration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (703)872-9306
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703) 305-4497.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

⁵ Because the 2 May, 2002, was and is not grantable, this period continues to run until such time as a grantable petition is filed.

⁶ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* 53131 at 53158 (10 October, 1997).

⁷ It Petitioner intends to allege that the delay(s) were due in whole or part to financial difficulties, Petitioner must submit: tax returns for each and every year, and bank statements for each and every month, both personal and business if the invention was assigned, commencing with the date of the Office action to which Petitioner failed to respond and continuing through the date on which a grantable petition is filed.